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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,619	10/30/2001	Michael Eneboe	01-489	5263

24319 7590 02/13/2004

LSI LOGIC CORPORATION
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MS: D-106 LEGAL
MILPITAS, CA 95035

EXAMINER

THOMPSON, ANNETTE M

ART UNIT	PAPER NUMBER
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2825

DATE MAILED: 02/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/021,619

Applicant(s)

ENEBOE ET AL.

Examiner

A. M. Thompson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5, 7, 9-11, 13-15, 17, 18, 22, 24, 25, 28, 31 and 33-36 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 5, 7, 9-11, 13-15, 17, 18, 22, 24, 25, 28, 31 and 33-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Applicant's amendment to 10/021,619 has been examined. The specification is amended. Claims 1-4, 6, 8, 12, 16, 19-21, 23, 26, 27, 29, 30, and 32 are cancelled. Claims 5, 7, 9, 11, 13, 14, 15, 17, 22, 24, 25, 28, 31, 33, and 34 are amended. Claims 5, 7, 9-11, 13, 14, 15, 17, 18, 22, 24, 25, 28, 31, 33-36 are pending.

1. Although Applicant's amendment is persuasive-in-part, this second non-final rejection on the merits issues because the instant rejection is not entirely necessitated by Applicant's amendment.

Claim Objections

2. Claims 1 and 25 are objected to because of the following informalities: Pursuant to claim 5, Applicant merely recites that the interconnect has a characteristic; for clarity, Applicant should additionally state what characteristic is being considered e.g. communication, performance. Pursuant to claim 25, at line 2, after "bandwidth", insert a verb for clarity. Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 18 and 25 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which Applicant regards as their invention. Applicant's specification at paragraph [0049] does not disclose what Applicant recites and it is unclear what Applicant is attempting to claim.

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Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 5, 7, 9-11, 13-15, 17, 22, 24, 28, 31, and 33-36 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,654,946 to Eneboe et al. Although the conflicting claims are not identical, they are not patentably distinct from each other. The following table correlates which claims (c.) or claim combinations in the instant application are obvious variations of the '946 patent claims or claim combinations:

Patent 6,654,946	Application 10/021,619
c. 1	c. 7
c. 12	c.5
c. 12, 13, 14	c. 9, 10, 11
c. 1, 4, 7	c. 11
c. 1, 9, 10	c. 13, 14
c. 1, 11	c. 15

Patent 6,654,946	Application 10/021,619
c. 22, 24	c. 17
c. 22, 31	c. 22
c. 22, 24	c. 24
c. 22, 31	c. 28
c. 32	c. 31
c. 32, 34	c. 33
c. 32, 36	c. 34
c. 32, 37	c. 34, 35
c. 32, 36, 38	c. 34, 36

7. Although the '946 patent includes the claim limitation of a method comprising synthesizing and the application includes the claim limitation of a method comprising extraction, it is clear from both patent and application disclosures that the method of extraction involves synthesis and the method of synthesis involves extraction. Therefore, these respective limitations do not result in patentably distinct claims.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please reference the PTO-892 for a complete listing.

9. Any inquiry concerning this communication or earlier communications should be directed to Examiner A.M. Thompson whose telephone number is (571) 272-1909. The Examiner can usually be reached Monday thru Friday from 8:00 a.m. to 4:30 p.m.. If

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attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Matthew S. Smith, can be reached on (571) 272-1907.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1562 or the Customer Service Center whose telephone number is (571) 272-1750.

10. Responses to this action should be mailed to the appropriate mail stop:

Mail Stop _____

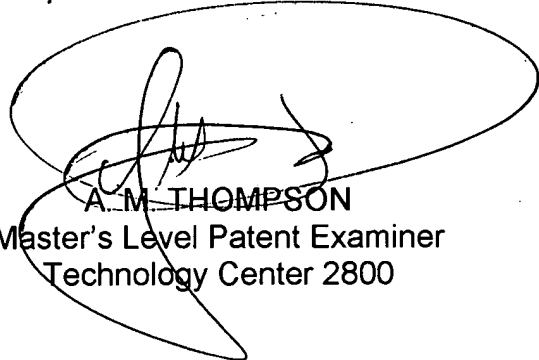
Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

or faxed to:

(703) 872-9306, (for all **OFFICIAL** communications intended for entry)



A.M. THOMPSON
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